

## **REMARKS**

Reconsideration and withdrawal of the rejections set forth in the Office action dated October 9, 2003 are respectfully requested. Applicants petition the Commissioner for a 3-month extension of time. A separate petition accompanies this amendment.

### **I. Amendments**

#### **A. In the Specification**

The specification is amended to correct obvious typographical errors.

#### **B. In the Claims**

Claims 6, 7, and 17 are amended to correct obvious typographical errors.

Claims 1, 10, and 20 are amended to recite a plurality of electrodes that are selectively advanceable to an individual deployment depth. Basis for this amendment can be found on page 12, line 23 through page 13, line 5 and in Fig. 22.

Claim 10 is further amended to recite a housing. Basis for this amendment can be found in Fig. 53A.

Claims 2, 3, 5, 11, 12, 18, are amended for consistent terminology.

Claim 9 is amended for clarity.

By these amendments, no new subject matter has been added.

### **II. Rejection under 35 C.F.R. §102**

Claims 1-7 were rejected under 35 U.S.C. §102(e) as allegedly anticipated by Cosman *et al.* (U.S. Patent No. 6,530,922).

Claims 10-19 were rejected under 35 U.S.C. §102(e) as allegedly anticipated by Behl *et al.* (U.S. Patent No. 6,337,998).

These rejections are respectfully traversed.

#### **A. The Present Invention**

The present invention, as embodied by claim 1, describes a method of controlling an ablation volume depth during surface treatment including (a) providing an apparatus,

where the apparatus comprises (i) a housing having a proximal end and a distal end including a tissue contacting surface having at least one aperture, and the housing defines an interior, (ii) an energy delivery device including a plurality of electrodes, each with a tissue penetrating distal end, the plurality of electrodes configured to be advanced from the housing interior through the at least one aperture and into a target tissue site to define an ablation volume at least partly bounded by the tissue surface, (iii) an advancement device coupled to the energy delivery device, where the advancement device is configured to selectively advance individual electrodes of the plurality of electrodes from the housing interior to a selected deployment depth. The method further comprises (b) positioning the tissue contact surface on a target tissue surface, (c) advancing the plurality of electrodes to the selected deployment depth beneath a tissue surface while avoiding a critical structure, (d) delivering ablative energy from the energy delivery device (e) creating an ablation volume at a controlled depth below the tissue surface responsive to the electrode advancement device, and (f) minimizing injury to the critical structure responsive to the electrode deployment depth.

The method, as embodied by claim 10, further includes an expandable member including a tissue contacting surface, where the expandable member has a non-deployed state and an expanded or deployed state.

#### B. The Prior Art

COSMAN ET AL. describe a cluster electrode instrument including a hub and at least three electrodes. In one embodiment, the instrument includes two electrodes attached to a plunger unit, which slides in a carrier or sheath. The guide bushing includes guide holes to guide the electrode shafts. The carrier may be held to the organ surface and the electrodes pushed in unison into the tissue.

BEHL ET AL. describe a system for treatment of target region beneath a tissue surface comprising a probe for deploying an electrode array within the tissue and a cover for engaging the tissue surface above the treatment site. The cover may be a rigid plate and may be clipped or otherwise removably attached to the probe. The cover may comprise electrode(s) or be electrically neutral.

C. Analysis

According to the M.P.E.P. § 2131, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference".

1. Rejection over Cosman *et al.*

Cosman *et al.* fail to teach providing an apparatus comprising an advancement device, where the advancement device is configured to selectively advance individual electrodes of the plurality of electrodes from the housing interior to a selected deployment depth. As seen in Fig. 7, the electrodes are inserted in unison to the same deployment depth.

2. Rejection over Behl *et al.*

Behl *et al.* fail to teach providing a tissue surface treatment apparatus comprising a housing with a tissue contacting surface having at least one aperture and a plurality of electrodes configured to be advanced from the housing interior through the aperture. The system of Behl *et al.* includes a cover deployed over the tissue surface to secure a probe that is used to introduce a plurality of electrodes to a tissue site. The cover can be a surface electrode to provide monopolar ablation with the plurality of electrodes at the tissue site. However, as seen in Fig. 4, the surface electrode is not advanced through an aperture in a housing.

Accordingly, Applicants submit that standard of strict identity to maintain a rejection under 35 U.S.C. § 102 has not been met. Withdrawal of the rejections under 35 U.S.C. § 102(e) is respectfully requested.

III. Rejections under 35 C.F.R. §103

Claims 8, 9, and 20 were rejected under 35 U.S.C. §103 as allegedly obvious over Cosman *et al.* further in view of Behl *et al.* This rejection is respectfully traversed.

A. The Present Invention

The present invention is described above.

B. The Prior Art

COSMAN ET AL. is described above.

BEHL ET AL. is described above.

Analysis

According to the MPEP § 2143, "to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references (or references when combined) must teach or suggest all the claim limitations."

As noted above, Cosman *et al.* fail to teach selectively advancing individual electrodes of the plurality of electrodes to a selected deployment depth.

The teaching in Behl *et al.* does not make up for this deficiency in Cosman *et al.*, since, as described above, Behl *et al.* does not even teach advancing a plurality of surface electrodes from at least one aperture in a housing, much less selectively advancing individual electrodes.

Thus, nowhere does either reference, taken alone or in combination, show or suggest selectively advancing individual electrodes of a plurality of electrodes to a selected deployment depth.

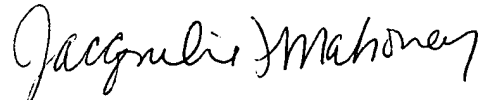
Because none of the references alone or in combination teach all the claim limitations of the present invention, the standard for obviousness has not been met. Accordingly, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. §103.

IV. CONCLUSION

In view of the foregoing, Applicants submit that the claims pending in the application are in condition for allowance. A Notice of Allowance is therefore respectfully requested.

The Examiner is invited to contact Applicants' representative at (650) 838-4410 if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted,



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